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FEB 18 2005

In re Application of :
Brown et al. :
Application No. 09/050,614 :
Filed: March 30, 1998 :
Attorney Docket Number: F-5231 : ON PETITION

OFFICE OF PETITIONS

This is a decision on the petition under 37 CFR 1.181 and Alternatively Request for Reconsideration Under 37 CFR 1.137(a), filed December 29, 2004.

The Petition under 37 CFR 1.181 is **dismissed**.

The Petition under 37 CFR 1.137(a) is **dismissed**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, and Notice of Allowability (hereinafter "Notices"), mailed March 13, 2003. The Notices set a non-extendable three (3) month period for reply. No response having been received, the application became abandoned on June 14, 2003. A Notice of Abandonment was mailed July 17, 2003.

Applicant filed a petition to revive the application under 37 CFR 1.137(b) on June 17, 2004, wherein Applicant averred that he did not receive the Notices. The petition was treated under 37 CFR 1.137(a) and dismissed. Applicant was advised that an allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. Applicant was advised to file a petition under 37 CFR 1.181 and alternatively, a Request for Reconsideration under 37 CFR 1.137(a).

Applicant was also advised that the Notice of Allowability required corrected drawings.

The instant petitions

Applicant files the instant petition under 37 CFR 1.181 and alternatively requests reconsideration under 37 CFR 1.137(a).

The petition under 37 CFR 1.181

The petition under 37 CFR 1.181 avers that the Notices were not received. In support of this assertion, Applicant provides a copy of a file jacket/docket record for this application. A review of the file jacket/docket record reveal that the assignee is Baxter International (of Round Lake, IL). Also noted on the file jacket/docket record is a Milwaukee, Wisconsin address which appears at the bottom of the file/jacket/docket record. It is unclear from the petition and the file jacket/docket record whether the file jacket and/or docket records referenced in the petition as having been searched were that of the address appearing in the petition:

RYAN KROMHOLZ & MANION, SC
Post Office Box 26618
MILWAUKEE, WI 53226,

or the correspondence address of record:

Bradford R.L. Price
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Round Lake, IL 60073.

Further to this, Applicant notes that the decision dismissing petition, mailed July 30, 2004, was incorrect in stating that the correspondence address has been changed. Applicant asserts that the correspondence address of record is and has always been

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which, Applicant also notes, is the address appearing on the Notice.

A review of the instant petition and of the three petitions filed in this application on February 7, 2003; June 17, 2004, and December 29, 2004, respectively, reveal that all of the petitions were signed by Petitioner using the address of

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The Milwaukee address that Applicant has used when filing his petition differs from the correspondence address of record, which is that of the assignee Baxter International (of Round Lake, IL).

Applicant is advised that the Notice was properly mailed to the correspondence address of record. Applicant has verified that the address on the Notice is the correspondence of record, and Office records indicate the Illinois address as the correspondence address of record.

Petitioner is obviously in Milwaukee, and the correspondence address of record is that of the assignee in Illinois. These circumstances point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

In absence of any irregularity in the mailing of an Office action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. However, here, the showing outlined above is not sufficient because there are circumstances that point to a conclusion that the Office communication may have been lost after receipt in Illinois rather than a conclusion that the Office communication was lost in the mail.

Petitioner's docket record is apparently evidence of receipt, or lack thereof, from the assignee, and bears no weight on whether the correspondence, properly mailed to the address of record, was received at the correspondence address of record.

Accordingly, the petition under 37 CFR 1.181 is dismissed.

Petition under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance,

or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks item (3) as set forth above.

Applicable Law

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.¹ 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.").

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff,

¹ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982)). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."² Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.³ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N.

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

Applicant's Assertion

Applicant asserts that the Notice was not received.

Analysis and Conclusion

As to item (3), Applicant has not provided an adequate showing of unavoidable delay because there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Alternative venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$750.00.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that

the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
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By FAX: (703) 872-9306
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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

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